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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

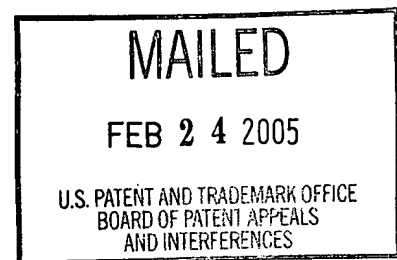
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY ODOM

Appeal No. 2004-2366
Application No. 09/707,194

ON BRIEF



Before HAIRSTON, JERRY SMITH and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 5, 7, 8, 10, 11, 13 and 15 through 20.¹ For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

The Invention

The invention relates to a system for toolbars on a computer. The system groups tools on a toolbar and allows the groups of tools displayed on the toolbar to be

¹ We note that the rejection of claim 4 is not before us, as appellant states on page 1 of the Appeal Brief that the rejection of claim 4 is not appealed.

expanded, revealing more tools in the group, or compressed, hiding tools in the group. (See figures 4 through 6 and page 4 of appellant's specification). Additionally, the system can re-arrange the tools within the toolbar based upon usage frequency. (See page 5 of appellant's specification).

Claims 5 and 15 are representative of the invention and is reproduced below:

5. Software from at least one computer-readable medium directly altering the length of a tool group in a toolbar exclusive of editing any tools in said group or altering the length of said toolbar.
15. Software from at least one computer-readable medium automatically rearranging at least one tool based upon relative usage frequency of tools within a toolbar group.

References

Tuniman et al. (Tuniman)	5,644,737	July 1, 1997
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Rejections at Issue

Claims 5, 7, 8, 10, 11, 13 and 15 through 20 stand rejected under 35 U.S.C. § 102 anticipated by Tuniman.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the

briefs,² along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellant and examiner, for the reasons stated *infra*, we will sustain the examiner's rejection of claims 5, 7, 8, 10, 11, 13, 19 and 20 under 35 U.S.C. § 102. However, we will not sustain the examiner's rejection of claims 15 through 18 under 35 U.S.C. § 102.

At the outset, we note that on page 7 of the appeal brief and pages 6 and 7 of the reply brief the appellant argues the impropriety of rejections based upon IBM technical disclosure bulletin vol. 36, No. 8, Arcuri (U.S. Patent 6,133,915) and Kavalam (U.S. Patent 6,057,836). The examiner has not presented these rejections in the final rejection, dated December 8, 2003, or the examiner's answer, dated May 4, 2004, therefore, these rejections are not before us for consideration.

Appellant argues, on page 6 of the brief, that Tuniman fails to anticipate the claimed invention as it fails to mention "tool groups." On page 3 of the reply brief appellant asserts

The central issue, really the only issue, is whether Tuniman's toolbars merge into a single toolbar when put together in a "stacked" toolbar, thus making a Tuniman toolbar a tool group in the confines of a stacked toolbar. This is the basis of Examiner's rejections. If instead, as Appellant contends, that Tuniman

² This decision is based upon the Appeal Brief received February 24, 2004 and the Reply Brief dated May 10, 2004.

maintained the integrity of the toolbars when confined within a stacked toolbar, then one must conclude that the claims under appeal should be allowed.

Further, Appellant asserts, on page 6 of the reply brief, that Tuniman “fails to even mention tool groups or their telltale dividers.”

We do find that the Tuniman’s “stacked” toolbar meets the claimed toolbar and that once the stacked toolbar is created the individual toolbars stacked meet the claimed “tool groups.”

Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims.

In re Etter 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant’s disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview*

Instruments, Inc., 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995).

“[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis

original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories*

Inc. 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning

that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817

(Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” ***Texas Digital Systems, Inc. v. Telegenix, Inc.***, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002). (“[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.”); ***Id.*** (citing ***Liebscher v. Boothroyd***, 258 F.2d 948, 951, 119 USPQ 133, 135 (C.C.P.A. 1958) (“Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.”)).

Appellant asserts, on page 4 of the reply brief:

The definition of a tool group is germane to all claims under appeal save 13. Page two of the 09/707,194 disclosure defines a tool group as follows: “Tools 2 are typically functionally segregated by group dividers 5. The set of tools 2 between group dividers 5, or between one end of a toolbar 1 and a group divider 5 is referred to as a group 6 of tools 2.”

We find that Tuniman’s individual toolbars once merged to a stacked toolbar meet this definition of a tool group. Tuniman teaches that when the stacked toolbar is created, the component toolbars are identified on the stacked toolbar by a logo. (See column 2, lines 43-50). A stacked toolbar is shown in figures 3 and 4 and described in column 6, lines 21 through 52. As seen in figure 3, the tools associated with the office

toolbar are between the left end of the stacked toolbar and a group divider (logo 32 associated with the office toolbar and line between logo 32 and logo 42). Similarly, in figure 4 the tools associated with the desktop toolbar are between two group dividers. Thus, we find that in the stacked toolbar the individual component toolbar are segregated by group dividers and meet the definition of the claimed tool group.

Appellant argues, on page 6 of the reply brief:

Claim 5 clearly limits claim scope to a “altering the length of a tool group in a toolbar exclusive of ... altering the length of the toolbar”. Tuniman discloses altering the length of a toolbar, but has no mention whatsoever of altering the length of a set of tools within a toolbar while not altering the length of a toolbar.”

We are not convinced by this argument. While we concur that Tuniman teaches that floating stacked toolbars can be resized (see column 7, lines 59-67), the resizing of a stacked toolbar by the user is not the teaching of Tuniman relied upon to meet the limitation of altering the length of a tool group. We find that appellant’s specification on page 2 defines the length of a toolbar or tool group as “the measurable distance from the head of the toolbar or group to it’s tale.” As stated *supra*, we find the component toolbars of Tuniman’s stacked toolbar to meet the claimed tool groups. Tuniman teaches that when the logo associated with a component toolbar is selected the tools for the previously displayed component toolbar are hidden and the tools for the selected component toolbar are displayed (see column 13, line 54 through column 14, line 11). Tuniman discloses that this process is animated to appear as one toolbar is sliding. (See column 3, lines 1-7). We consider

this animation of sliding one component toolbar, a tool group, to reveal it's tools while hiding another component toolbar, tool group, to meet the claimed altering the length of a tool group. Further, we do not find that Tuniman teaches or suggests that the length of the stacked toolbar should be adjusted while the selected tools are sliding. Rather, we find that Tuniman teaches that any resizing is such that the resized stacked toolbar will accommodate all of the component toolbars, tool groups, in the resized stacked toolbar. (See column 10, lines 6-10). Accordingly, we sustain the examiners rejection of claim 5.

Appellant argues, on page 8 of the reply brief:

The point of claim 7 is "to hide at least one tool" by "contracting the length of a tool group". Tuniman discloses hiding an entire toolbar in (10:34-52), or stacking toolbars such that a portion of one may be obscured (12:6-24), but never anticipates hiding a tool within a toolbar, let alone hiding a tool within a tool group, as claim 7 stipulates.

We are not convinced by this argument. As stated *supra* we find that Tuniman teaches creating a stacked toolbar from component toolbars and that the component toolbars meet the claimed tool groups. Further, Tuniman teaches that when the logo associated with a component toolbar is selected the tools for the previously displayed component toolbar, tool group, are hidden and the tools for the selected component toolbar, tool group, are displayed (see column 13, lines 54-67). We consider this feature of sliding and hiding to meet the claim 7 limitation of "contracting the length of

a tool group to hide at least one tool without change in toolbar length.” Accordingly, we sustain the examiner’s rejection of claim 7.

Appellant argues, on page 9 of the reply brief, “Tuniman Figures 3-4 have no indication and the attendant disclosure makes no mention of a tool group or tool group divider, let alone tool group divider manipulation.”

As stated *supra*, with respect to claim 5, we find that the component toolbars in Tuniman’s stacked toolbar teach the claimed tool groups and that the logos Items 32 and 42 are dividers between the tool groups. Tuniman teaches that the user selects a component toolbar, tool group, by clicking logo (see column 14, lines 1-5). We find that the clicking on the logo meets the claim 8 step of manipulating the group divider. Accordingly, we sustain the examiner’s rejection of claim 8.

Appellant argues, on page 11 of the reply brief, “Tuniman in Figures 6 and 7, and attendant disclosure, describes showing and hiding all tools of an entire toolbar. In showing the tools of a toolbar, the length of the toolbar changes, as clearly shown in Tuniman’s figures. Claim 10 specifies showing a tool ‘without a change in toolbar length’.”

We are not persuaded by appellant’s arguments. As stated *supra*, with respect to claim 5, we find that the component toolbars meet the claimed tool groups and that length of the stacked toolbar is not changed when the different tool groups are selected. Inasmuch as appellant is arguing that Tuniman teaches that the number of

tools displayed in the toolbar changes when different tool groups are selected, we concur. However, we find no limitation in claim 10 which requires the number of tools displayed on the toolbar to be unchanged. As stated *supra*, we find that the length of the toolbar to be a measure of distance not a measure of number of tools displayed. Accordingly, we sustain the examiner's rejection of claim 10.

On page 8 of the reply brief appellant states "[c]laims 8 and 11 are covered here together owing to their similarity in claim limitations." Claim 11 is dependent upon claim 10. For the reasons stated *supra* with respect to the examiner's rejection of claims 8 and 10, we sustain the examiner's rejection of claim 11.

Appellant argues, on pages 11 through 15 of the reply brief, that Tuniman does not teach merging two toolbars into one and therefore does not anticipate claim 13. Appellant states, on page 15 of the reply brief, that the term "merge" means "to cause to combine unite or coalesce." Further, appellant asserts, "Tuniman's stacked toolbar may be most accurately defined as 'confining' multiple toolbars together." Further, on page 14 of the reply brief, appellant states:

Applicant disclosed the claimed process of merging toolbars as follow [sic, follows] "Figure 4 depicts two toolbars 1 arranged horizontally end-to-end. Depicted in Figure 5, toolbars may be **merged (joined)** 11: a tail-end 21 toolbar 1 ... may be joined 11 to a head-end toolbar.

We are not convinced by these arguments. We find that the toolbars used to create Tuniman's stacked toolbar are merged. Tuniman teaches that component toolbars can be added to, combined with, the other component toolbars in the stacked

toolbar. (See column 2, lines 51-59). Further, Tuniman teaches that the form of the stack may be such that the component toolbars are displayed side-by-side. (See column 6, lines 25-30). Thus, we find that Tuniman teaches merging toolbars as claimed in claim 13 and we sustain the examiner's rejection of claim 13.

Appellant argues on pages 16 through 18 of the reply brief, that the rejection of claim 15 is improper, as Tuniman does not teach automatic rearrangement of tools within a group based upon relative usage. Further, on page 21 of the reply brief, appellant argues that claim 17 is a variant of claim 15 and as such appellant's arguments also apply to claim 17.

The examiner states, on page 4 of the answer, that "Tuniman discloses automatically rearranging at least one tool based upon a relative usage frequency of tools within a toolbar group [.. a user will arrange a number of frequently used applications in different groups based on subject matter or common task relationship.; see col. 1, lines 30-37.]".

We concur with the appellant. Claim 15 contains the limitation of "automatically rearranging at least one tool based upon relative usage frequency of tools within a toolbar group." Claim 17 contains a similar limitation. While we agree with the examiner that Tuniman teaches that the user can rearrange the tools, we do not find that Tuniman teaches that the rearrangement is automatic based upon relative usage

frequency of tools within toolbar group. Accordingly, we will not sustain the examiner's rejection of independent claims 15 and 17 or dependent claims 16 and 18.

Appellant's argue, on pages 22 and 25 of the reply brief, that the rejection of claim 19 is improper as "Tuniman never suggests being able to select or move 'a group of tools within a toolbar'."

We disagree with the appellant. Claim 19 includes the limitation "directly selecting and moving a group of tools within a toolbar." As stated *supra*, we find the component toolbars of Tuniman's stacked toolbar to be tool groups. Further, as stated *supra*, we find that Tuniman teaches that a user selecting the logo associated with the component toolbar causes the selected tool group to be displayed. The change of display of tool groups is animated such that one tool group slides into view as another is hidden. We find that this sliding of the tool group meets moving a group of tools as claimed in claim 19.

Appellant argues on pages 23 through 25 of the reply brief, that the rejection of claim 20 is improper. On page 25 of the reply brief appellant asserts "Tuniman does not make any suggestion that toolbars themselves may be subgroup, thus failing to anticipate tool groups, and possible manipulations of tool groups as a separate entity from the toolbar in which they reside. Tuniman fails to anticipate the concept of allowing a user through direct manipulation merging groups of tools."

We are not convinced by appellant's arguments. As stated *supra*, with respect to claim 5, we find that Tuniman does teach tool groups as claimed. Further, as stated *supra*, with respect to claim 13, we find that Tuniman teaches merging two toolbars into one. Accordingly, we sustain the examiner's rejection of claim 20.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellant (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger* 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit Court stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit Court, the issue is waived. *See also In re Watts* 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In summary, we sustain the examiner's rejection of claims 5, 7, 8, 10, 11, 13, 19 and 20 under 35 U.S.C. § 102. However, we will not sustain the examiner's rejection of claims 15 through 18 under 35 U.S.C. § 102. The decision of the examiner is affirmed-in-part.

Appeal No. 2004-2366
Application No. 09/707,194

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

)BOARD OF PATENT
) APPEALS AND
)INTERFERENCES

RN/RWK

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